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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/598,852

10/18/2006

Christine R. Russell

3415-01

1298

26645

7590

12/16/2008

THE LUBRIZOL CORPORATION

ATTN: DOCKET CLERK, PATENT DEPT.

29400 LAKELAND BLVD.

WICKLIFFE, OH 44092

EXAMINER

WALTERS JR, ROBERT S

ART UNIT

PAPER NUMBER

1792

MAIL DATE

DELIVERY MODE

12/16/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/598,852

Applicant(s)

RUSSELL ET AL.

Examiner

ROBERT S. WALTERS JR

Art Unit

1792

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE-US)
Paper No(s)/Mail Date 9/13/2006
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Application

Claims 1-20 are pending and presented for examination.

Specification

Abstract

The abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(4). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

Claim Objections

Claims 1 and 18 are objected to because of the following informalities: Claim 1 should make clear that the aqueous discontinuous emulsified material represents a water-in-oil emulsion or make it clearer that water is the discontinuous phase. The "maybe" should be removed from claim 18 and changed to "selected from the group consisting of liquefied compressed gases, non-liquefied compressed gases, and mixtures thereof." Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 3-5, 8, 10, 12-15, 17, 18, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Leep et al. (U.S. Pat. No. 4362838).

Regarding claims 1, 3-5, 8, 10, 12-15, 17, 18, and 20, Leep teaches a method of coating a substrate comprising applying a water-in-oil emulsion (abstract) to the surface and allowing the material to dry by evaporation (column 2, lines 28-30) to provide a surface coating (column 4, lines 14-20), which is either a black enamel or clear varnish (see Examples, columns 3 and 4). Leep further teaches that the aqueous phase can be present in up to 80% (see Leep at claim 1) and 28-51% (making it a major amount) of the emulsified material (see Leep at claim 7), and that the non-aqueous phase can be present in the claimed range (as a minor amount when the water is present in 51%) and consists of solvents and polymeric material (see any of the examples in columns 3 and 4), and finally that a emulsifier can be added, such as sorbitan trioleate in 0.32% (see Example at bottom of column 3). Leep also teaches that a propellant can be added to the composition (column 4, lines 14-19) such that the water-in-oil emulsion can be applied by spraying from an aerosol container using the compressed propellant (column 4, lines 14-19).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 6, 7, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leep.

Regarding claims 6, 7, and 16, Leep teaches all the limitations of claim 1, but fails to explicitly teach the aqueous phase being in the range of 60-85%, or the claimed viscosity, and coating thickness. However, it would have been obvious to one of ordinary skill in the art at the time of the invention that the amount of the aqueous phase and the thickness of the coating would effect its sagging and ultimately the final appearance and the quality of the coating.

Further, it would have been obvious to one of ordinary skill in the art at the time of the invention to optimize the viscosity of the composition by adding thickeners or solvents, such that the emulsion has a suitable viscosity to be applied by what ever application method is desired. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to choose the instantly claimed ranges, for the aqueous phase content, viscosity, and coating thickness, through process optimization, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. See In re Boesch, 205 USPQ 215 (CCPA 1980).

3. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Leep in view of Leep et al. (U.S. Pat. No. 4365028, hereinafter referred to as Leep2).

Regarding claim 2, Leep teaches all the limitations of claim 1, but fails to teach removing the coating from the surface. Leep2 teaches a similar water-in-oil emulsion coating composition that can be applied by aerosol spraying (abstract and column 2, lines 6-10). Leep2 further teaches that this composition can be removed from the surface of the substrate by sanding or stripping through conventional methods (column 2, lines 34-38). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Leep by adding the additional step of removing the coating, as taught by Leep2. One would have been motivated to make this modification as this would allow for refinishing of the substrate after the coating has been worn to an unacceptable appearance by scratches and other blemishes.

4. Claims 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leep in view of Schlarb et al. (U.S. Pat. No. 6348528).

Regarding claims 9 and 11, Leep teaches all the limitations of claim 1, but fails to specifically teach the use of the coating as a protective barrier, and the application to a specific substrate. Schlarb teaches applying emulsion paints to substrates, such as wood, concrete, metal, and glass (column 6, lines 38-42). Schlarb further teaches the use of these dispersions as corrosion protection coatings (column 5, lines 20-29). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Leep's method by including an anticorrosive agent and applying the composition to a metal substrate, as taught by Schlarb, to provide that substrate with corrosion protection. One would have been motivated to make this modification as this would obviously impart an additional level of protection and durability to any substrate that was treated by Leep's method.

5. Claims 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leep in view of French et al. (U.S. Pat No. 5027901).

Regarding claims 9 and 11, Leep teaches all the limitations of claim 1, but fails to specifically teach the use of the coating as a protective barrier, and the application to a specific substrate. French teaches the use of high water content water-in-oil emulsions for protecting oil wells (abstract), having steel pipes (column 1, lines 18-20) wherein the water phase is emulsified into an oil phase containing the anticorrosion agent (see Preparation of the Emulsion, column 6)

and applied to the steel substrates. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Leep's method by including an anticorrosive agent and applying the composition to a metal or steel substrate, as taught by French, to provide that substrate with corrosion protection. One would have been motivated to make this modification as this would obviously impart an additional level of protection and durability to any substrate that was treated by Leep's method.

6. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Leep in view of Cross (U.S. Pat. No. 3647690).

Regarding claim 19, Leep teaches all the claim 1, but fails to teach the emulsified material having a non-aqueous phase comprising grease and an anticorrosion modifier. Cross teaches a grease composition comprising grease and an anticorrosion agent (Example 1, column 4). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Leep's method to include in the non-aqueous phase this grease and anticorrosive composition. One would have been motivated to make this modification as this would impart an additional level of protection and durability to any substrate that was treated by Leep's method.

Pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Thomas (U.S. Pat. No. 3929499)

Grasshoff (U.S. Pat. No. 4115282)

Filippini et al. (U.S. PGPUB No. 2004/0176263)

Manka et al. (U.S. PGPUB No. 2003/0220205)

Conclusion

Claims 1-20 are pending.

Claims 1-20 are rejected.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT S. WALTERS JR whose telephone number is (571)270-5351. The examiner can normally be reached on Monday-Thursday, 6:30am to 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Barr can be reached on (571)272-1414. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

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like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ROBERT S. WALTERS JR/

December 11, 2008

Examiner, Art Unit 1792

/Michael Barr/

Supervisory Patent Examiner, Art Unit
1792
